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27777	7590	08/11/2009	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			KASZTEJNA, MATTHEW JOHN	
			ART UNIT	PAPER NUMBER
			3739	
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			08/11/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/674,186

**Applicant(s)**

NOBIS ET AL.

**Examiner**

MATTHEW J. KASZTJEJNA

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-16 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-13, 15 and 22-26 is/are rejected.
- 7) ☒ Claim(s) 14 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Notice of Amendment***

In response to the amendment filed on April 30, 2009, amended claims 10, 14, 16 and 22 are acknowledged. The rejections under 35 U.S.C. 112, second paragraph are *withdrawn*. The rejection of claim 16 is *withdrawn*. The following reiterated grounds of rejection of claims 10-15 and 22-26 are set forth:

### ***Claim Objections***

Claim 16 is objected to because of the following informalities: Line 8 of the claim should read: "the flexible shaft extends from *the* housing along an axis generally aligned with *the* length of the housing". The words "the" were omitted from the claim amendment. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-13, 15 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,443,944 to Doshi et al.

**In regards to claim 10**, Doshi et al. disclose a medical device comprising: a flexible member 15; an end effector 10a-b, 11a-b, 12a-b operatively associated with a distal end of the flexible member; and an elongate handle 5 extending longitudinally from a handle proximal end to a handle distal end, the handle being operatively

associated with the proximal end of the flexible member, wherein the flexible member extends from an end of the elongate handle along an axis generally parallel to a longitudinal axis of the elongate handle (see Figs. 6-7); wherein the handle is sized and shaped to be gripped by a single hand; wherein the handle comprises an actuator 7a-b operable by the same hand for operating the end effector through the flexible member (see Col. 8, Lines 51-58) with a portion of the flexible member in a looped configuration behind the same hand, and wherein an outer surface of the handle is sized and shaped to be gripped by a single hand and wherein the actuator is disposed on the handle (see Col. 10, Lines 59-65). **In regard to claim 22**, the handle 5 comprises a release operatively associated with the end effector (see Col. 7, Lines 38-49). Doshi et al. disclose that the flexible member may be up to 50 inches long depending upon the particular application in which the device is to be used (See Col 4, Lines 10-32). Thus, if the flexible member 15, as seen in Figures 6-7, is constructed with a length of 50 inches, then the flexible member would be fully capable of being looped in any configuration around the hand as recited in the instant claims. Furthermore, it is clear from Figures 6-7, that a user would be fully capable of holding the handle with one hand, with the middle finger of that hand free to operate lever 7a-b and the index finger and thumb of the same hand free to manipulate the flexible member. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, the words "to be" in the claim may be properly interpreted as "capable of,"

and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

**In regards to claim 11**, Doshi et al. disclose a medical device wherein the end effector is a grasping forceps (see Figs. 8a-c and Col. 6, Lines 11-20).

**In regards to claims 12-13**, Doshi et al. disclose a medical device wherein the flexible member has a length of at least 1 meter (see Col. 4, Lines 15-33).

**In regards to claims 15 and 24**, Doshi et al. disclose a medical device, wherein the actuator comprises a lever 7a-b positioned to be squeezed between fingers of the same hand holding the handle and a housing position of the handle, and wherein the lever extends alongside the housing portion of the handle, the lever having a length that is at least half the length of the handle (see Figs. 6-7).

**In regards to claim 23**, Doshi et al. disclose a medical device, wherein the release 4 is disposed at a first end of the handle and wherein the flexible member 15 extends from a second, opposite end of the handle 5 (See Figs. 6-7).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 25-26 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,443,944 to Doshi et al. in view of U.S. Patent No. 6,620,184 to de Laforcade et al.

**In regards to claims 25-26**, Doshi et al. disclose a system for operating a flexible endoscopic device with one hand (see rejections above) but are silent with respect to a release operable for returning the end effector to the first configuration. De Laforcade et al. teach of an analogous apparatus having a ratchet release mechanism for a medical device. The release mechanism permits both a smooth and a stepped actuation of a grasper on a distal end of the medial device. The medical device has a fixed handle and a movable handle. The release mechanism comprises an elongated toothed plate arrangement supported in a release housing and an elongated smooth plate arranged adjacent the toothed plate arrangement in the release housing. The release housing is pivotably supported between the handles to permit the handles to move in a stepped or a smooth manner to effect actuation of the grasper (see Figs. 1 and 2). It would have been obvious to one skilled in the art at the time the invention was made to include a release mechanism in the apparatus of Doshi et al. to provide a actuator that is simple to operate and inexpensive to manufacture and to provide a release mechanism which permits that medical grasper device to be multi-functional, to maintain and/or to immediately release a grasping or treatment configuration to that medical device as taught by de Laforcade et al.

***Allowable Subject Matter***

Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 16 is allowed.

The following is a statement of reasons for the indication of allowable subject matter:

Doshi et al. disclose a system for operating a flexible endoscopic device with one hand comprising: an end effector 10a-b, 11a-b, 12a-b having a first and second configuration (See Figs. 8a-c), a handle 5, a flexible shaft 15 extending intermediate the end effector and the handle; the handle comprising: a housing, the housing being longer than the housing is wide, and sized and shaped to be grasped by a single hand; an actuator 7a-b comprising a lever extending lengthwise alongside the housing (see Figs. 6-7) and operable by the hand holding the housing to actuate the end effector from a first configuration to a second configuration (See Col. 7, Lines 8-36) and a release 4 (see Col. 7, Lines 38-49). However, Doshi et al. is silent with respect to wherein the flexible shaft extends from the housing along an axis generally aligned with the length of the housing. Furthermore, one of ordinary skill in the art would not have been motivated to modify the handle of Doshi et al. with the prior art of record, as realigning the flexible shaft of Doshi et al. to extend in the direction as claimed (axially aligned with the length of the handle), would teach against the functionality of the handle as taught by Doshi et al.

***Response to Arguments***

Applicant's arguments filed April 30, 2009 have been fully considered but they are not persuasive.

Applicant states that Doshi et al. fail to disclose a flexible member that extends from an end of the elongate handle along an axis generally parallel to a longitudinal axis of the elongate handle. Examiner disagrees. Claims 10 and 22 fail to positively define longitudinal and horizontal axes with respect to the apparatus. A frame of reference is not provided, therefore, the longitudinal axis (i.e. a lengthwise axis) may be interpreted in either a vertical or horizontal direction with respect to the apparatus. Thus, as broadly as claimed, Doshi et al. disclose an elongate handle extending longitudinally from a handle proximal end to a handle distal end, wherein the flexible member extends from an end of the elongate handle along an axis generally parallel to a longitudinal axis of the elongate handle. The handle would then be longitudinally extended from a distal end to a proximal end and the flexible member would extend along an "axis" generally parallel with the "longitudinal axis" of the elongate handle. Doshi et al. meet the current limitations of the claims, as the length (i.e. longitudinal axis) of the handle is interpreted as being aligned with the flexible member and the width of the handle is interpreted as the portion of the handle which extends transversely to the flexible member, as seen in Figs. 6-7.

In response to applicant's argument that Doshi et al. fail to disclose operation of the flexible member with the thumb and index finger, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed



invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In the instant case, if the flexible member 15, as seen in Figures 6-7, is constructed with a length of 50 inches, then the flexible member would be fully capable of being looped in any configuration around the hand as recited in the instant claims. Furthermore, it is clear from Figures 6-7, that a user would be fully capable of holding the handle with one hand, with the middle finger of that hand free to operate lever 7a-b and the index finger and thumb of the same hand free to manipulate the flexible member. It is emphasized that the words "to be" in the claim may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

The applicant further states that Doshi et al. teach away the recited claim language, as Figs 6-7 show at least three finger grooves on the lower part of the handle 5, and as such it contemplates at least three fingers grasping the lower part of the handle. Examiner disagrees. Firstly, claims 16 and 22 of the instant invention do not require the remaining fingers of the hand to fully grasp the handle, nor does the apparatus of Doshi et al. require a user to fully grasp each finger groove to ensure functionality of the apparatus. In fact, a user could fully operate (i.e. open/close,

retract/protrude the forceps 10) the apparatus of Doshi et al. with no fingers placed within the finger grooves, but rather by holding the apparatus with two hands placed around the apparatus, one holding actuator 1, and another grasping lever 7a-b. Handle 5 is provided for a user's convenience and ergonomic comfortably and has no effect on the operability of the overall device. If the handle was removed, the apparatus would still be fully functionable. Furthermore, grasping the handle is entirely dependant upon a user's personal preference, which is largely influenced by the size and dexterity of the individual's hand(s). Thus, if a user is most comfortable grasping the handle with one hand, with the middle finger of that hand free to operate lever 7a-b and the index finger and thumb of the same hand free to manipulate the flexible member 15, nothing in the apparatus of Doshi et al. would prevent the user from doing so, and the device would still be fully operable. Thus, as broadly as claimed, Doshi et al. meet the current limitations of the claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew J Kaszlejna/  
Examiner, Art Unit 3739

8/10/09

